

REMARKS

Claims 22-38, 54-59, and 78-121 are pending in the Application. Claims 22-38, 54-59, and 78-95 were rejected, and claims 96-121 were withdrawn by the Office, in the Office action mailed October 14, 2008. Claims 22, 30, 54, 78-86, 96, and 109 are amended and new claims 122-133 are added by this response. Claims 22, 30, 54, 78, 96, and 109 are independent claims. Claims 23-29, 87-89, 122, and 123, claims 31-38, 90-92, 124, and 125, claims 55-59, 93-95, 126, and 127, claims 79-86, 128, and 129, claims 97-108, 130, and 131, and claims 110-121, 132, and 133 depend, respectively, from independent claims 22, 30, 54, 78, 96, and 109.

Applicants respectfully request reconsideration of claims 22-38, 54-59, and 78-121, and consideration of claims 122-133, in view of the amendments set forth above, in light of the arguments that follow.

Restriction of Claims

The Office constructively elected 22-38, 54-59, and 78-95 of the Application, and withdrew from consideration claims 96-121, asserting at page 2:

Newly submitted claims 96-121 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the invention originally claimed and claims 96-121 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination of claims 96-121 has separate utility such as selecting a transmission data rate for transmissions between two stations. See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 96-121 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicants respectfully disagree with the assertion by the Office, respectfully submit that the Office has not met the requirements of M.P.E.P. §806.05(d), and respectfully request reconsideration. M.P.E.P. §806.05(d), cited by the Office states, in part:

>To support a restriction requirement where applicant separately claims plural subcombinations usable together in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctness and **reasons for insisting on restriction are necessary**. Each subcombination is distinct from the combination as claimed if:

(A)the combination does not require the particulars of the subcombination as claimed for patentability (e.g., to show novelty and unobviousness), and

(B)the subcombination can be shown to have utility either by itself or in another materially different combination.

See MPEP § 806.05(c). Furthermore, **restriction is only proper when there would be a serious burden if restriction were not required**, as evidenced by separate classification, status, or field of search.

(emphasis added)

Applicants respectfully submit that the Office has failed to even mention that “there would be a serious burden if restriction were not required”, as mandated by M.P.E.P. §806.05(d), and that the withdrawal from consideration of claims 96-121 and constructive election of claims 22-38, 54-59, and 78-95 by the Office, is improper, for at least this reason.

Further, Applicants respectfully submit that the Office has failed to set forth any evidence or support for such an assertion, and that such evidence is also required by M.P.E.P. §806.05(d). Therefore, Applicants respectfully submit that the withdrawal from consideration of claims 96-121 and constructive election of claims 22-38, 54-59, and 78-95 by the Office, is improper for at least this additional reason.

Amendments to the Claims

Claims 22, 30, 54, 78, 96, and 109 have been amended to more clearly describe the subject matter of the claims. Support for these amendments may be found, for

example, at pages 28-34, 112, and 113 of the Application. Applicants respectfully submit that these amendments do not add new matter.

Rejections of Claims

Claims 78-86 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 22, 26-30, 36-38, 54, 56-57, 78, 80, 81, and 84-95 were rejected under 35 U.S.C. §103(a) as being unpatentable over Heidari (US 5,550,893) in view of Mahany (US 4,910,794). Claims 25, 31, 55, and 79 were rejected under 35 U.S.C. §103(a) as being unpatentable over Heidari in view of Mahany and admitted prior art. Claims 23, 24, 32, 33, 58, 59, 82, and 83 were rejected under 35 U.S.C. §103(a) as being unpatentable over Heidari in view of Mahany, and further in view of Gleeson, et al. (US 5,446,736, hereinafter "Gleeson"). Applicants respectfully traverse the rejections for the reasons set forth during prosecution, and those that follow.

I. Claims 78-86 Are In Compliance With 35 U.S.C. §112, ¶1

Claims 78-86 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. The Office asserts, in part, at page 3:

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "Computer-readable storage" nor the limitation " A computer-readable storage, having stored thereon a computer program having a plurality of code sections for operating a portable terminal device supporting voice communication via a wireless packet network, the code sections executable by a processor for causing the processor to perform the operations" was disclosed or defined in the original disclosure, thus the limitation is considered new matter.

Applicants respectfully traverse the rejection. Notwithstanding, Applicants have amended claims 78-86 to use the term "computer-readable medium" in place of the

term “computer-readable storage”, as shown above. M.P.E.P. §2106.01(I) states, in part: “...a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.” Thus, the term “computer-readable medium” is recognized by the Office as a computer element which, when encoded with a computer program, is statutory.

Applicants respectfully submit that Applicants’ disclosure recites the term “mobile terminal” at least 28 times, including references to “mobile terminals 5521, 5522, 5523, ... 5555, 5559, ... 5581....” Applicants respectfully submit, for example, that “mobile terminal 5523” that communicates via a “premises network” teaches a “portable terminal device [that] support[s] voice communication via a wireless packet network”. See *id.* at page 255, lines 1-7. Applicants respectfully submit that the “mobile terminals” of Applicants’ disclosure comprise a “computer program” for use by a processor. For example, see *id.* at page 260, lines 17-20, which states, in part, “...Upon receipt of the reply packet , the terminal 5523 offers to the user and/or software of the terminal 5523 the telephone line routing pathways (in this case only one) 20 identified in the reply packet.” Applicants further respectfully submit that the participants on the “premises network (LAN)” use, for example, a “wireless transceiver 3110” shown in Fig. 30, and described at, for example, pages 151-157 of the Application. In particular, Applicants respectfully point out that “transceiver 3110” comprises a “microprocessor 3120”. See instant Application at Fig. 30. One of ordinary skill in the art would immediately recognize without question that the presence of “software” in the “mobile terminal 5523”, and the disclosure of a “microprocessor 3120” in, for example, the “transceiver 3110” means that the “mobile terminal 5523” inherently has a “computer-readable medium” that stores the “software of the terminal 5523” for execution by a processor (e.g., “microprocessor 3120”). Applicants further respectfully submit that it is well known to those of ordinary skill in the relevant art that software comprises various sections, such as “functions”, “modules”, “subroutines”, and the like.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that Applicants' disclosure complies with 35 U.S.C. 112, first paragraph, and that although the term "computer-readable storage" does not explicitly appear in the disclosure, one of ordinary skill in the relevant art would unquestioning recognize that the Application does disclose "...[a] computer-readable storage, having stored thereon a computer program having a plurality of code sections for operating a portable terminal device supporting voice communication via a wireless packet network, the code sections executable by a processor for causing the processor to perform the operations." Nevertheless, Applicants have amended claims 78-86 to as shown above, in agreement with usage in the M.P.E.P., to further prosecution of the Application. Therefore, Applicants respectfully request that the rejection of claims 78-86 under 35 U.S.C. §112, first paragraph, be reconsidered and withdrawn.

II. The Proposed Combination Of Heidari And Mahany Does Not Render Claims 22, 26-30, 36-38, 54, 56, 57, 78, 80, 81, And 84-95 Unpatentable

Claims 22, 26-30, 36-38, 54, 56-57, 78, 80, 81, and 84-95 were rejected under 35 U.S.C. §103(a) as being unpatentable over Heidari in view of Mahany.

With regard to independent claim 22, Applicants have amended claim 22 to recite, in part, "...[a] portable terminal device ... comprising: ... wherein the portable terminal device evaluates a message wirelessly received from the base station and sends to the base station an indication of a data rate based on the evaluation; and wherein the portable terminal device receives digital voice packets transmitted by the base station at a data selected by the base station based upon the indication of a data rate." Applicants respectfully submit that the Office has not shown where the proposed combination of references teaches at least these aspects of Applicants' claim 22.

Applicants appreciate recognition by the Office that "...Heidari does not teach the mobile telephone evaluates a message wirelessly received from the base station and sends to the base station an indication of a data rate based on the evaluation; and wherein the base station selects a data rate for transmitting digital voice packets to the mobile telephone, based upon the indication of a data rate." See *id.* at page 4.

The Office continues by stating, at page 4:

Mahany teaches a system and method that includes a mobile telephone evaluates a message wirelessly received from a base station (column 22 lines 3-19) and sends to the base station an indication of a data rate based on the evaluation (column 22 lines 20-24); and wherein the base station selects a data rate for transmitting messages to the mobile telephone, based upon the indication of a data rate. (column 22 line 25-27)

Applicants disagree with the interpretation of Mahany set forth by the Office. The Applicants respectfully note that the Office cites only Mahany, and only at column 22, lines 3-19, 20-24, and 25-27 as teaching Applicants' claim feature. Applicants now address the Mahany reference, but first review the portion of Mahany that begins just before the cited sections, at column 21, line 60, which is reproduced below:

Consider a radio system that consists of several units, each with a unique address.

(1) In the simplest case, the system may consist of two units, #1 and #2, one or both of which are mobile.

(2) In a standby mode of operation both units program their receivers to receive at the low data rate.

(3) When a unit has information to communicate, it switches to transmit at the standard rate, and sends a query to the other (target) unit. Following this transmission, the unit switches to once again receive at the standard rate.

This first portion of Mahany at column 21, line 60 to column 22, line 2, teaches that in a "standby" mode, a unit receives at a "low" data rate, and that when a unit has information to communicate, it switches to a "standard" data rate, sends a query to a "target" (receiving) unit, and then switches back to the "low" data rate. Applicants respectfully submit that the use of the recited data rates is not "based upon the indication of a data rate [sent to the base station by the portable terminal device]", in accordance with Applicants' claim 22. Applicants now review the cited portion of Mahany at column 22, lines 3-19, which recites:

(4) If the target unit for some reason (e.g. out of

range) does not correctly receive the query it makes no response. After a time out period, the initiating unit may periodically attempt to re-establish the link.

(5) If the target unit correctly receives the transmission it performs an analysis to determine the quality of the radio link (propagation path and radio hardware). This may involve combinations of signal strength measurement, jitter in the received data, or use of information communicated in the transmission. A transmission which is to be evaluated as an aid to deciding on a dynamic basis whether a high data rate is feasible is herein termed a "test signal" or "test transmission." Based upon the results of the analysis, the unit determines whether to utilize the standard data rate or a higher rate for a subsequent communications session between the two units.

(emphasis added)

This cited portion of Mahany teaches that if the "target" (receiving) unit does not receive the "query", it does not respond, and that the "sending" unit may periodically retry. However, if the "target" (receiving) unit does receive the query, the "target" (receiving) unit performs an analysis to determine the quality of the radio link. The "target" (receiving) unit then determines whether to use the "standard" data rate or a "higher" data rate for communication between the units. In other words, the receiving end of the communication link (the one that performed the analysis), decides what data rate will be used to transmit information sent to it.

Applicants now look at the cited portion of Mahany at column 22, lines 20-24, shown below:

(6) The target unit completes the handshake by switching to transmit at the standard rate and communicates its data rate selection to the initiating unit. It then switches to receive at either the standard or higher data rate depending on which it has selected.

(emphasis added)

Thus, Mahany teaches that the "target" (receiving) unit selects the data rate to be used in sending data to it. We now turn to the final cited portion of Mahany, at column 22, lines 25-27, which state:

(7) The initiating unit, upon receipt of the return

handshake, switches to transmit its message at the selected data rate.
(emphasis added)

This last portion makes clear that the unit that initiated the communication of information to the “target” (receiving) unit switches to a data rate **selected by the “target” (receiving) unit.**

Applicants respectfully submit that the portions of Mahany cited by the Office do not teach or suggest Applicants’ claim 22 prior to the current amendment, let alone amended claim 22, which states, in part, “...wherein the portable terminal device evaluates a message wirelessly received from the base station and sends to the base station an indication of a data rate based on the evaluation; and wherein the portable terminal device receives digital voice packets transmitted **by the base station** at a data rate **selected by the base station** based upon the indication of a data rate. Applicants respectfully submit that, in contrast, the cited portions of Mahany teach that a receiving first unit performs an analysis, and that the first unit **selects a data rate** to be used by the transmitting second unit for transmitting information to the first unit. In Mahany, it is the receiving unit that selects the data rate, and the sending unit simply uses the selected rate provided to it by the receiving unit. It is clear from the cited portions of Mahany that there is no selection of a data rate at the sending unit, based upon an indication of data rate [sent to it by another unit].

Applicants’ claim 22 as amended, however, recites “...wherein the portable terminal device (first unit) evaluates a message wirelessly received from the base station (second unit) and sends to the base station (second unit) an indication of a data rate based on the evaluation; and wherein the portable terminal device (first unit) receives digital voice packets transmitted by the base station (second unit) at a data rate selected by the base station (second unit) based upon the indication of a data rate.” Applicants’ claim feature allows the “base station” to take other factors into account in selecting a data rate to use in transmission to the portable terminal device. Applicants respectfully submit that the unit in Mahany that initiates the communication, (that is, the one transmitting information) does not select the data rate. Mahany teaches that only the data rate sent to it by the receiving unit is used. The word “select” may be

reasonably defined as "...to choose (as by fitness or excellence) from a number or group: pick out...." See Merriam-Webster's Collegiate Dictionary, Tenth Edition, ©2002, Merriam-Webster, Incorporated, page 1056. Thus, "selection" requires alternatives, and the cited portions of Mahany do not teach that the sending unit has any choice in the data rate to be used. Instead, the sending unit simply uses the data rate selected by the unit that is receiving the information (that is, the "target" unit of Mahany). Therefore, the cited portions of Mahany fail to teach or suggest at least this patentably distinct aspect of Applicants' claim 22.

Applicants again respectfully note that the Office cited only Mahany as teaching this aspect of Applicants' claim 22. Because the Office admitted that Heidari does not teach this aspect of Applicants' claim 22, and Applicants have shown that the cited portions of Mahany also do not teach or suggest this feature, Applicants respectfully submit that it necessarily follows that the proposed combination of Heidari and Mahany cannot teach or suggest at least this patentable aspect Applicants' claim 22.

In addition, Applicants respectfully submit that the rejection of claim 22 as set forth by the Office simply recites a feature of claim 22, and then simply cites a portion of the Mahany reference that allegedly teaches Applicants' claim feature, without providing "...the clear articulation of the reason(s) why the claimed invention would have been obvious..." which M.P.E.P. §2142 recognizes is "...[t]he key to supporting any rejection under 35 U.S.C. 103...." The Office fails to provide any explanation or interpretation of how the cited portions of Mahany teach the identified aspects of Applicants' claim 22. Applicants have shown above that, in fact, the portions identified by the Office do not teach what is allegedly taught. Therefore, Applicants respectfully submit that for this reason alone, the Office has not established a *prima facie* case of obviousness in accordance with M.P.E.P. §2142.

Further, the Office states, at page 5:

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the system and method of Heidari to include the mobile telephone evaluating a message wirelessly received from the base station and sending to the base station an indication of a data rate based on the evaluation; and

wherein the base station selects a data rate for transmitting digital voice packets to the mobile telephone, based upon the indication of a data rate as suggested by Mahany because it provides for maintaining reliable performance in fringe reception areas by adaptively selecting the best data rate dynamically according to changing operating conditions.
(emphasis added)

This conclusory statement is simply a recitation of a portion of Applicants' claim 22, followed by an unattributed reason of why it would have been obvious to make the combination. The reason given is not a "generic reason" such as "faster", "better", or "cheaper", but is quite specific. The source of this alleged motivation is not identified, however, which leads the Applicant to wonder whether this "motivation" is the result of improper hindsight. Applicants respectfully submit that M.P.E.P. §2142 makes clear that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there **must** be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." The Office has failed to articulate how the combination of Heidari and Mahany results in the subject matter of Applicants' claim 22, and therefore fails to establish a *prima facie* case of obviousness in accordance with M.P.E.P. §2142.

In addition, Applicants have amended claim 22 to recite, in part, "[a] portable terminal device for supporting voice communication via a wireless packet network, the device comprising: ... a second receiver operating according to a short range wireless communication protocol, the portable terminal device transmitting, via the wireless packet link, digital voice packets assembled using digitized voice information received by the second receiver;...." Applicants respectfully submit that the proposed combination of references does not teach or suggest at least this distinct and patentable aspect of Applicants' claim 22, and that claim 22, and any claims that depend therefrom, are allowable over the proposed combination of references for at least this additional reason.

With regard to independent claims 30, 54, and 78, Applicants respectfully submit that claims 30, 54 and 78 have been amended to recite features similar to those of amended claim 22, and that the Office rejected claims 30, 54, and 78 asserting similar

arguments based upon the same sections of the cited art. Therefore, Applicants respectfully submit that independent claims 30, 54, and 78 are allowable over the proposed combination of references as well. Because claims 23-29 and 87-89, claims 31-38 and 90-92, claims 55-59 and 93-95, and claims 79-86 depend, respectively, from independent claims 22, 30, 54, and 78, Applicants respectfully submit that claims 23-29 and 87-89, claims 31-38 and 90-92, claims 55-59 and 93-95, and claims 79-86 are also allowable over Heidari and Mahany, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 22, 26-30, 36-38, 54, 56, 57, 78, 80, 81, and 84-95 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

III. Claims 96-121 Are Allowable Over Heidari And Mahany

The Office withdrew claims 96-121 from consideration, and failed to identify any prior art, or set forth any basis for the rejection of claims 96-121 under either 35 U.S.C. §102 or 35 U.S.C. §103.

Applicants have shown above that the withdrawal from consideration of claims 96-121 was improper. Therefore, Applicants respectfully submit that the Office has failed to set forth a proper rejection of claims 96-121, and that amended claims 96-121 are allowable, for at least the reasons set forth above.

IV. The Proposed Combination Of Heidari, Mahany, And Admitted Prior Art Does Not Render Claims 25, 31, 55, And 79 Unpatentable

Claims 25, 31, 55, and 79 were rejected under 35 U.S.C. §103(a) as being unpatentable over Heidari in view of Mahany and admitted prior art. Applicants respectfully submit that claims 25, 31, 55, and 79 depend, respectively, from claims 22, 30, 54, and 78. Applicants respectfully submit that amended claims 22, 30, 54, and 78 are also allowable over the proposed combination of references, in that the Office has not demonstrated how and why the admitted prior art overcomes the shortcomings of Heidari and Mahany set forth above. Because amended claims 22, 30, 54, and 78 are allowable over the proposed combination of references, Applicants respectfully submit that claims 25, 31, 55, and 79 that depend therefrom, are also allowable, for at least the reasons set forth above. Accordingly, Applicants respectfully request that the rejections

of claims 25, 31, 55, and 79 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

V. The Proposed Combination Of Heidari, Mahany, And Gleeson Does Not Render Claims 25, 31, 55, And 79 Unpatentable

Claims 23, 24, 32, 33, 58, 59, 82, and 83 were rejected under 35 U.S.C. §103(a) as being unpatentable over Heidari in view of Mahany, and further in view of Gleeson. Applicants respectfully submit that claims 23 and 24, 32 and 33, 58 and 59, and 82 and 83 depend, respectively, from independent claims 22, 30, 54, and 78. Applicants respectfully submit that amended claims 22, 30, 54, and 78 are also allowable over the proposed combination of references, in that the Office has not shown how and why Gleeson overcomes the shortcomings of Heidari and Mahany set forth above. Because claims 22, 30, 54, and 78 are allowable over the proposed combination of references, Applicants respectfully submit that claims 23, 24, 32, 33, 58, 59, 82, and 83 that depend therefrom, are also allowable, for at least the reasons set forth above. Accordingly, Applicants respectfully request that the rejections of claims 23, 24, 32, 33, 58, 59, 82, and 83 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Newly Added Claims

New claims 122-133 have been added by this amendment. New claims 122-123, 124-125, 126-127, 128-129, 130-131, and 132-133 depend, respectively, from allowable independent claims 22, 30, 54, 78, 96, and 109, and are therefore also allowable. Support for new claims 122-133 may be found, at least, at pages 32, 39-66, 123, and 154, and Figs. 2, 3a, 3b, 6a, 6b, 7a, 7b, 8, 21, 22, 23, and 24 of the Application. Applicants respectfully submit that new claims 122-133 do not add new matter.

Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

Appln. No. 10/760,035
Filing Date: January 16, 2004
Reply to Office action mailed October 14, 2008
Amendment dated February 17, 2009

The Applicants believe that all of pending claims 22-38, 54-59, and 78-133 are in condition for allowance. Therefore, an early Office Action on the merits and allowance of claims 22-38, 54-59, and 78-133 is respectfully requested.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000 to resolve any issues.

Respectfully submitted,

Dated: February 17, 2009
McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
(312) 775-8000

By /Kevin E. Borg/
Kevin E. Borg
Reg. No. 51,486